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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/584,671 | 06/26/2006 | Kristof De Spiegeleer | 6142-00504 | 5006 |

86942          7590          08/19/2010
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| EXAMINER |
|---|
| CALLAHAN, PAUL E |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2437 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 08/19/2010 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | Application No. | Applicant(s) |
|---|---|---|
| | 10/584,671 | DE SPIEGELEER, KRISTOF |
| **Office Action Summary** | Examiner | Art Unit | |
| | PAUL CALLAHAN | 2437 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>25 June 2010</u>.

2a) ☐ This action is **FINAL.**     2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>1-4 and 6-17</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-4, 6-17</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All  b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail. Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1.      A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection.  Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114.  Applicant's submission filed on 6-25-

2010 has been entered.


2.      Claims 1-4 and 6-17 are pending and have been examined.


### *Response to Arguments*

3.      Applicant's arguments filed 6-25-2010 have been fully considered but they are

not persuasive.

        The Applicant argues that the claims as presented in the latest amendment may

be distinguished from the teachings of the reference used in the 35 USC 102(b)

rejections of the claims: Farber et al., US 5,978,791 (henceforth Farber).

        The Applicant argues that Farber fails to teach the limitations recited by claim 1

of receipt and replacement of a file with a different version, in the manner recited by the

claim.  However, the Examiner respectfully maintains that Farber does indeed teach the

steps recited by claim 1. The Examiner points to the sections of Farber cited in the

rejection of claim 1, and additionally at col. 24 lines 45-62 Request True File, and col.

25 lines 25-45 Acquire True File). In these sections Farber discloses remote a remote

mechanism where a remote processor can require a local processor to store a copy of a

file, and respond to requests for an indication as to whether the local processor already

has a copy if the file. The Examiner maintains that these sections in combination with

those set forth in the rejection of the claim read on the limitations of claim 1.

The Applicant argues that Farber additionally fails to teach the limitation recited

by claim 9 of sending the content attributes of a file to every computing device

containing said file. However, the Examiner respectfully maintains that Farber does

indeed teach this feature at the sections cited in the rejection of the claim. In Farber at,

for example, col. 23 line 53 through col. 24 line 29 Farber discloses a method for

requesting a file from a remote processor where file content attributes (True Name) are

broadcast to source processors with a flag indicating that such a request is to be

forwarded. The Examiner maintains that this reads on the claim limitation.


### Specification

4.      Claim elements "means for calculating" and "means for identifying" found in

claims 9, 11 and 12 are means (or step) plus function limitations that invoke 35 U.S.C.

112, sixth paragraph. The written description only implicitly or inherently sets forth the

corresponding structure, material, or acts that perform the claimed function.

Pursuant to 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181, applicant is

required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites the corresponding structure, material, or acts that perform the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function.

### *Claim Rejections - 35 USC § 112*

5.      The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.      Claims 6 and 17 are rejected under 35 U.S.C. 112, first paragraph as single means claims, i.e., where a means recitation does not appear in combination with another recited element of means. From MPEP 2164.08:  *A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197(Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose*

*was held nonenabling for the scope of the claim because the specification disclosed at*

*most only those means known to the inventor.). When claims depend on a recited*

*property, a fact situation comparable to Hyatt is possible, where the claim covers every*

*conceivable structure (means) for achieving the stated property (result) while the*

*specification discloses at most only those known to the inventor.*

7.    The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

8.    Claims 9-17 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

As for claim 9, claim elements: "means for calculating" and "means for

identifying" are means (or step) plus function limitations that invoke 35 U.S.C. 112, sixth

paragraph. However, the written description fails to disclose the corresponding

structure, material, or acts for the claimed function. It is not clear from the Applicant's

disclosure which parts of the "network environment" recited by claim 9 carry out the

functions of identifying and calculating as set forth in the claim. The Specification does

not recite specific algorithms or specific processor devices for carrying out these

functions.

As for claims 11 and 12, these claims also contain the claim elements of "means for identifying" and are therefore rejected on the same basis as claim 9.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

As for claims 10 and 13-17, these claims are dependent from claim 9 and do not cure its deficiency. Therefore they are rejected on the same basis as is claim 9.

### Claim Rejections - 35 USC § 101

9.      35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10.     Claims 6 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The preamble of these claims indicate that they are directed towards a computer-program that directs a processor to undertake the method steps of independent base claims 1 and 9 respectively. However, neither of claims 6 or 17, or their base claims contain a limitation directed towards the computer-program being stored in a *non-transitory* computer-readable medium. Therefore claims 6 and 17 set forth only functional descriptive language and are non-statutory since this does not fall into one of the classes of invention eligible for the grant of a US patent. Unless embodied in a non-transitory computer-readable medium the software in and of itself cannot be considered as a computer component, and hence cannot effect a change of state of a processor to produce a useful or tangible result.

## *Claim Rejections - 35 USC § 102*

11.    The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12.    Claims 1-4 and 6-17 are rejected under 35 U.S.C. 102(b) as being clearly

anticipated by Farber et al., US 5,978,791. Farber teaches:

       As for claim 1, a method for identifying the content of a file in a network

environment (abstract), said network environment comprising at least one local

computing device linked to a remaining part of the network environment including a

central infrastructure (fig. 1(a), col. 4 line 63 through col. 5 line 35), and the method

comprising: receiving a new file on said local computing device (col. 14 lines 1-31),

calculating a reference value for a new file on one of said at least one local computing

devices using a one-way-function (col. 14 lines 1-31), transmitting said calculated

reference value to said central infrastructure (col. 16 lines 38-62, col. 23 line 52 through

col. 24 line 29), comparing said calculated reference value with reference values

previously stored within the remaining part of the network environment (col. 16 lines 38

through col. 17 line10, col. 23 line 52 through col. 24 line 29), after comparing, deciding

that the content of the new file is already identified if a match between said calculated

reference value and a previously stored reference value is found and retrieving the

corresponding content attributes (col. 14 line 40 through col. 15 line 10, col. 23 line 52 through col. 24 line 29, col. 25 lines 26-45 );  or deciding that the content of the new file is not yet identified if no match between said calculated reference value and any of the previously stored reference values is found (col. 14 line 40 through col. 15 line 10, col. 23 line 52 through col. 24 line 29), followed by sharing the new file on the local computing device to said central infrastructure and said central infrastructure identifying the content of said new file by remotely identifying the content over the network environment (col. 23 line 52 through col. 24 line 29, col. 25 lines 26-45), determining content attributes corresponding with the content of the new file and storing a copy of said content attributes (col. 25 lines 26-45), after deciding, triggering an action on said local computing device in accordance with said content attributes (col. 25 lines 26-45), wherein said triggering an action on said local computing device in accordance with said content attributes comprises replacement of the new file on the local computing device with a different version of said new file restored from the remaining part of the network environment. (col. 25 lines 26-45).

As for claim 2, a method according to claim 1, wherein said triggering an action on said local computing device in accordance with said content attributes is performed after transmitting the content attributes corresponding to the new file to the local computing device (col. 25 lines 26-45).

As for claim 3, a method according to claim 1 wherein said identifying the content of said new file comprises one or more of the group of scanning for viruses, scanning for adult content, scanning for Self Promotional Advertising Messages and scanning for copyrighted information, using a scanning means installed on said central infrastructure (col. 34 lines 33-43).

As for claim 4, a method according to claim 1, furthermore comprising storing a copy of the new file on the central infrastructure (col. 25 lines 26-45).

As for claim 6, a computer readable storage medium comprising program instructions for executing the method of claim 1 when executed on a network (col. 4 line 58 through col. 5 line 16).

As for claim 7, the claim represents the system carrying out the method of claim 1. Claim 7 recites substantially the same limitations as claim 1 and is rejected on the same basis as that claim.

As for claim 8, a system according to claim 7 furthermore comprising means wherein the central infrastructure is further configured to store a copy of the new file within the remaining part (col. 4 line 58 through col. 5 line 24).

As for claim 9, a method for altering a system for identifying the content of a file in a network environment (abstract), said network environment comprising means for calculating a one-way function (col. 12 lines 54-60), at least one local computing device linked to a remaining part of the network environment including a central infrastructure and means for identifying the content and said remaining part including a stored database (col. 4 line 58 through col. 5 line 60), the method comprising altering said means for identifying the content or said means for calculating a one-way function (col. 14 lines 1-31, col. 16 lines 38-62, col. 23 line 52 through col. 24 line 29), scanning the remaining part of the network environment for reference values calculated with a one-way function for each of said reference values (col. 16 line 10 through col. 17 line 10), requesting a file that corresponds with said reference value from said network environment identifying the content of said file (col. 16 line 38 through col. 17 line 10), and determining content attributes corresponding with the content of the file and storing a copy of said content attributes, sending the content attributes to every local computing device containing the file (col. 23 line 53 through col. 24 line 29, col. 25 line 25-45); after sending, triggering an action on said local computing device in accordance with said content attributes (col. 25 lines 25-45), wherein said triggering an action on said local computing device in accordance with said content attributes comprises replacement of the new file on the local computing device with a different version of said new file restored from the remaining part of the network environment. (col. 25 lines 26-45).

As for claim 10, a method according to claim 9, wherein said scanning the remaining part of the network environment for reference values calculated with a one-way function comprises scanning the remaining part of the network environment for reference values, calculated with a one-way function, said reference values being generated after a predetermined date (col. 35 lines 10-28).

As for claim 11, a method according to claim 9, wherein said method furthermore comprises, for each of said reference values, sending the file to means for identifying the content (col. 23 line 54 through col. 24 line 28).

As for claim 12, a method according to claim 9, wherein said method furthermore comprises, for each of said reference values, sharing the file to the means for identifying the content and remotely identifying the content of the file over the network (col. 23 line 54 through col. 24 line 28).

As for claim 13, a method according to claim 9, wherein said sending the content attributes to every local computing device containing the file, comprises identifying every local  computing device containing the file using a stored database sending the content attributes to said identified local computing devices (col. 23 line 54 through col. 24 line 28).

As for claim 14, a method according to claim 9 wherein sending the content attributes to said identified local computing devices comprises, for each of said identified local computing devices not connected to said network, creating an entry in a waiting list and sending the content attributes to said identified local computing devices in agreement with said entry on said waiting list when the local computing devices are reconnected to the network (col. 43 lines 9-15: Offline processors are queried on reconnection, therefore a queue is inherent to the system).

As for claim 15 a method according to claim 9 wherein, requesting a file that corresponds with said reference value from said network environment comprises, if no local computing device having said file that corresponds with said reference value is connected to the network, creating an entry in a waiting list and requesting a file that corresponds with said reference value from said local computing device in agreement with said entry when the local computing device is reconnected to said network (col. 43 lines 9-15: Offline processors are queried on reconnection, therefore a queue is inherent to the system).

As for claim 16, a method according to claim 9, wherein said method furthermore comprises identifying whether the content attributes correspond with unwanted content and, if so, identifying the local computing device that first introduced said unwanted content in the network based on data stored in said database (col. 34 lines 33-43).

As for claim 17, a computer program product for executing the method as claimed in claim 9 when executed on a network (col. 4 line 58 through col. 5 line 16).

## *Conclusion*

13.    Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869.  The examiner can normally be reached on M-F from 9 to 5. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865.  The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.  Status information for published applications may be obtained from either Private PAIR or Public PAIR.  Status information for unpublished applications is available through Private PAIR only.  For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/PEC/
AU2437

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